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John C McMahon P O Box 30069 Kansas City, MO 64112			PATEL, YOGESH P	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER P. JACKSON

Appeal 2010-000493
Application 09/644,777
Technology Center 3700

Before WILLIAM F. PATE III, MICHAEL W. O'NEILL, and
KEN B. BARRETT, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Roger P. Jackson (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1-7, 9-26, 50, and 51. Claims 8 and 27-49 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The claimed invention is to a medical implant. In particular, the claimed invention is directed to a combination of an open headed medical implant and a threaded closure for clamping a rod into the bight of the open headed portion of the medical implant. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

A medical implant having a head with a pair of spaced arms and an implant closure sized to be operably threadedly received between said arms; said closure having a threadform thereon that is sized and shaped to be threadedly received in a mating threadform on said arms; said closure has a direction of advancement along an axis of rotation relative to said head; said threadform comprising:

- a) a leading surface that has an inner edge and an outer edge;
- b) a trailing surface that has an inner edge and an outer edge; and wherein
- c) intersections of a plane passing through said axis of rotation with both said leading surface and said trailing surface slope rearwardly relative to the direction of advancement from the respective inner edges to the outer edges thereof.

The Prior Art

The Examiner relies upon the following as evidence of unpatentability:

Reed	US 5,499,892	Mar. 19, 1996
Morrison	US 6,296,642 B1	Oct. 2, 2001

Grounds of Rejections

The following Examiner's rejections are before us for review:

Claims 1-7, 9, 10, 12-26, and 50-51 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Morrison.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Morrison and Reed.

Argument

Since the Appellant does not separately argue the patentability for claims 1-7, 9, 10, 12-26, and 50-51 against Morrison, we select claim 1 as the representative claim. Claims 2-7, 9, 10, 12-26, and 50-51 will stand or fall with claim 1. Claim 11 will be treated separately.

SUMMARY OF DECISION

We AFFIRM.¹

OPINION

Appellant “acknowledges that the invention shown in Morrison, et al. essentially shows and describes the invention called for in Claims 1 to 7, 9 to 10, 12 to 26 and 50 to 51 of the present application.” App. Br. 11. As such, it is our finding that Morrison describes the claimed subject matter on appeal.

Appellant urges that he:

¹ During the course of our review of the Examiner’s adverse decision, we noted a significant similarity between the claimed subject matter defined in Morrison and the claims on appeal. As such, we suggest the Examiner consult with the Interference Practice Specialist in the Examiner’s Technology Center. Further, we suggest the Appellant review 35 U.S.C. § 135; 37 C.F.R. § 41.202(d); and MPEP § 2305. If the “same invention” could be claimed between Morrison and Appellant, then a showing of priority is made under 37 C.F.R. § 41.202(d); not 37 C.F.R. § 1.131.

conceived of the disclosed and claimed subject matter of his application and reduced it to practice prior to the effective date of Morrison, et al., that is prior to November 9, 1998, in the United States. Further, it is also urged that the invention was reduced to practice with due diligence in conjunction with or in the alternative to being reduced to practice prior to the effective date of Morrison.

To support applicant's position, applicant has submitted three Declarations dated February 25, 2003; February 23, 2006 and March 12, 2007 which are attached hereto as exhibits outlining applicant's conception and reduction to practice. Where possible applicant has submitted supporting documents and pictures of prototypes; however, applicant suffered a catastrophic fire that burnt his entire house and destroyed some records and prototypes that were located there at the time of the fire.

App. Br. 11-12.

As such, it appears Appellant is trying to establish prior invention of the claimed subject matter to Morrison with alternative positions: 1) actual reduction to practice or 2) conception of the invention prior to the effective date of Morrison coupled with due diligence from prior to Morrison's effective date to a subsequent (actual) reduction to practice.

An Appellant may overcome a reference by: (1) a showing of facts that the effective date of the reference is not "before the invention by the applicant for patent" (antedating), or (2) a showing of facts that the relevant

disclosure in the reference is not “by another” (derivation)². 35 U.S.C. § 102(e).

To antedate Morrison, Appellant must establish invention of the subject matter of the rejected claims prior to the effective date of the reference by showing facts sufficient to establish reduction to practice prior to the effective date. 37 C.F.R. § 1.131(b). Rather than proving reduction to practice, Appellant may attempt to prove conception of the invention prior to the effective date coupled with due diligence from prior to the effective date to a subsequent reduction to practice or to the filing of the application. *Id.* The rule specifically requires the presentation of evidence proving facts establishing reduction to practice of the invention prior to the effective date of the reference or a satisfactory explanation of the absence of such evidence. *Id.* The facts to be established under 37 C.F.R. § 1.131 are similar to those to be proved in interference. The difference lies in the way that the evidence is presented.

Proof of actual reduction to practice requires a showing that 1) an apparatus actually existed and 2) worked for its intended purpose. Our reviewing court has stated that there are some devices so simple that the

² To prove derivation, and remove a patent reference that is the basis of a rejection that is not a statutory bar, the applicant must submit evidence establishing: (1) that the patentee derived his or her knowledge of the relevant subject matter from applicant, and (2) that applicant made the invention upon which the relevant disclosure in the patent is based. *See In re Mathews*, 408 F.2d 1393 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 1407 (“The real question is whether, in addition to establishing derivation of the relevant disclosure from himself, appellant has also clearly established the fact that he invented the relevant subject matter disclosed in the patent.”). *See also* Manual of Patent Examining Procedure (MPEP), 8th ed., rev. 8, July 2010, §§ 715.01(c) II, 716.10.

actual existence of the apparatus is all that is necessary to constitute actual reduction to practice. *In re Asahi/America Inc.*, 68 F.3d 442, 445 (Fed. Cir. 1995). Our reviewing court has also stated “[d]epending on the character of the invention and the problem it solves, determining that the invention will work for its intended purpose may require testing.” *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998).³

The evidence presented to us in the form of declarations and exhibits does not suggest that this threadform was a simple device. Indeed, the evidence and statements suggest a contrary character. Jackson Declaration, Feb. 25, 2003, paras. 8 and 10 (1995 Jenkins could not manufacture a prototype; 1999 capable of manufacturing a prototype); Jackson Declaration, Oct. 12, 2006⁴, paras. 5 and 7 (1997 Jenkins able to manufacture the “plug,” yet no evidence nor mention that the “a head with a pair of spaced arms and an implant closure sized to be operably threadedly received between said

³ Citing to *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1578 (Fed. Cir. 1996) (“To show actual reduction to practice, an inventor must demonstrate that the invention is suitable for its intended purpose. *Scott v. Finney*, 34 F.3d 1058, 1061, 32 USPQ2d 1115, 1118 (Fed.Cir.1994”). Depending on the character of the invention and the problem it solves, this showing may require test results. *Id.* at 1062; *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 550, 16 USPQ2d 1587, 1592 (Fed.Cir.1990). Less complicated inventions and problems do not demand stringent testing. *Scott*, 34 F.3d at 1062. In fact, some inventions are so simple and their purpose and efficacy so obvious that their complete construction is sufficient to demonstrate workability. *Id.*; *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 861, 226 USPQ 402, 407 (Fed. Cir. 1985), cert. denied, 475 U.S. 1016, 106 S. Ct. 1197, 89 L.Ed.2d 312 (1986).”).

⁴ While the Appeal Brief fails to submit this declaration into evidence, the declaration is discussed in the Jackson Declaration of Mar. 12, 2007, and is present within the file wrapper.

arms; said closure having a threadform thereon that is sized and shaped to be threadedly received in a mating threadform on said arms” was manufactured.) Accordingly, we determine that the character of this invention, in order to establish actual reduction of practice, requires both actual construction and testing for its intended purpose. While the Jackson Declarations mention testing, no evidence of testing data has been submitted. Thus, we find there is insufficient evidence submitted to establish testing for its intended purpose was performed on an apparatus that corresponds to every element of the claimed invention.

For the above reasons, we find the Appellant fails to establish actual reduction of practice of the claimed subject matter.

Turning to the other avenue of antedating presented by Appellant, conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction of practice, *arguendo* the Fall of 1999 (*see* Jackson Declaration, Feb. 25, 2003, paras. 10-11, Exhibits H-L), we find that the entire period which diligence is required is insufficiently accounted for by either affirmative acts or acceptable excuses. Dr. Jackson declares he never lost interest in the concept of using reverse angle thread on a bone screw closure and continued to pursue making and testing a prototype. Jackson Declaration, Feb 25, 2003, para. 9. However, we find insufficient evidence is submitted to adequately support such a statement and, further we find large amounts of inactive time are not accounted for within the declarations.

For the above reasons, we find the Appellant fails to establish conception of the invention prior to the effective date of the reference

coupled with due diligence from prior to the reference date to a subsequent actual reduction of practice.

As a result of finding the Appellant failing to establish actual reduction of practice of the claimed subject matter, or in the alternative, conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent actual reduction of practice, we further find that the Appellant has failed to antedate Morrison. Accordingly, we find Morrison is prior art to Appellant's claimed invention and, since it is acknowledged by Appellant that Morrison describes the claimed subject matter within claim 1, we find Morrison anticipates claim 1. Since claims 2-7, 9, 10, 12-26, and 50-51 fall with claim 1, these claims are anticipated as well by Morrison.

For the above reasons, we see no reversible error with the Examiner finding that the declarations, arguments, and evidence submitted by Appellant insufficient to establish a reduction to practice prior to the effective date of Morrison. Ans. 5-6. As a result, we sustain the Examiner's rejection under § 102(e) with Morrison.

Turning to the obviousness rejection, Claim 11 relies on the same position as with claim 1, namely the invention predates the effective date of Morrison. App. Br. 15. We have explained *supra*, why we find the declarations, arguments, and evidence insufficient to antedate Morrison. Those reasons fully respond to Appellant's argument and evidence against the obviousness rejection and are incorporated herein. As result, we sustain the Examiner's obviousness rejection under § 103(a) with Morrison and Reed.

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DECISION

The decision of the Examiner to reject claims 1-7, 9-26, and 50-51 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

Klh